

REMARKS

This paper is filed in response to the office action mailed on May 3, 2006. Claims 1, 14, 17, 23, 27 and 30 have been amended; claims 1-32 stand rejected; claims 1-32 remain pending.

Claim 17 and 30 stand objected to as lacking proper antecedent basis for "the cooling." In response, claims 17 and 30 have been amended to recite "a cooling" thereby traversing these objections.

Claims 1-2, 4, 8-9, 11-15, 18-19, 21, 23, 27 and 31 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,292,321 ("Lee"). In response, independent claims 1, 14, 23 and 27 have been amended to traverse this rejection.

Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'

Citing, Verdegaaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

Lee cannot serve as an anticipating reference because it fails to teach or suggest separate inner and outer tubes as now recited in each pending independent claim. Lee only discloses a single catheter 12 with a unitary elongated body 14. The structure of the body 14 is clearly a unitary molded article as evidenced by the cross hatching shown in Figs 1, 1a, 2 and 2a. Further, Fig. 3 of Lee clearly shows that the elongated body 14 is unitary in structure with separate passages 22, 24.

Thus, applicants respectfully submit that the Patent Office has interpreted Lee too broadly and that Lee does not teach or suggest inner and outer tubes as recited in the independent claims. Thus, Lee cannot serve as an anticipating reference and the anticipation rejection based upon Lee is improper and should be withdrawn.

Next, the Office Action rejects claims 3 and 20 under 35 U.S.C. § 103 as being unpatentable over Lee in view of U.S. Patent No. 5,035,694 ("Kasprzyk"). However, under MPEP § 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure

Citing, In re Vaeck, 947 F 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Kasprzyk is only cited for the proposition that it teaches a heating element in the form of a coil. Kasprzyk does not teach or suggest the inner and outer separate tubes as recited by the pending independent claims. Therefore, no combination of Lee and Kasprzyk teaches or suggests every element of the pending independent claims and therefore the obviousness rejections of dependent claims 3 and 20 are improper and should be withdrawn

Next, claim 10 is rejected under 35 U.S.C. § 103 as being obvious in view of Lee in combination with U.S. Patent No. 6,270,521 ("Fischell"). However, while Fischell discloses separate inner and outer tubes, the combination of Lee and Fischell also fails to teach or suggest structural limitations common to each independent claim. Specifically, both Lee and Fischell fail to teach or suggest a distal tip on its inner tube 12 which has a maximum outer diameter that is equal to or greater than the maximum outer diameter of the stent in an unexpanded form. The Lee tip diameter does not meet the maximum diameter of the stent 19 as clearly shown in Fig. 1 of Lee.

Instead of using a protective tip, Fischell relies upon a sheath 30, 32, 34 and securing tube 16 to hold the distal portion of the sheath 34 against the distal tip 15 (see Fig. 1). These structures are rendered unnecessary by the present invention as the distal tip 12 of the present application is big enough to protect the stent 26. In contrast, the distal tip 15 of Fischell is not big enough to protect the stent 40 and the additional structures 30, 32, 34 and 16 are required (Fischell at Col. 4, line 65 to Col. 5, line 11).

Therefore, no combination of Lee and Fischell teaches or suggests every element of each independent claim and, in particular, amended claim 1. Specifically, Lee fails to teach or suggest separate inner and outer tubes and the distal tip of Lee is clearly not equal to or greater than the stent 19 in an unexpanded state as shown in Fig. 1 of Lee and required by amended claim 1. Fischell, on the other hand, teaches separate inner and outer tubes but the Fischell tip 15 is not larger or equal to the unexpanded stent 40 as shown in Fig.

1 and Fig. 2C. Even if one were to consider the securing tube 16 to be apart of the distal tip 15, the securing tube 16 is not larger than or equal to the unexpanded stent 40 in diameter as shown in Figs. 1 and 2C of Fischell. Therefore, no combination of Lee and Fischell teaches or suggests every element of the independent claims, and in particular, independent claim 1. Accordingly, the obviousness rejection of claim 10 is improper and should be withdrawn.

Next, claims 5-7, 16, 17, 24-26 and 29-30 are rejected under 35 U.S.C. § 103 as being unpatentable over Lee in view of U.S. Patent No. 6,579,305 ("Lashinski"). In response, each pending independent claim has been amended thereby traversing this rejection. The deficiencies of Lee are noted above. Lashinski also fails to teach or suggest a structure having a separate inner and outer tubes whereby the inner tube includes a distal tip having a maximum outer diameter that is equal to exceeds that of the stent when the stent is in an unexpanded condition. This is made clear by Fig. 2 of Lashinski. Therefore, no combination of Lee and Lashinski teaches or suggests separate inner and outer tubes whereby the inner tube has a distal tip that has a maximum diameter that is equal to or exceeds that of the unexpanded stent. Accordingly, the obviousness rejection based upon Lee and Lashinski is improper and should be withdrawn.

Finally, claims 22 and 32 are rejected under 35 U.S.C. § 103 as being unpatentable over Lee in view of U.S. Patent No. 6,174,327 ("Mertens"). In response, each independent claim has been amended to remove Lee as a proper base reference. Mertens is only cited for the proposition that it teaches a removable sheath which is actually rendered unnecessary by the structures of the pending independent claims. Mertens teaches nothing about a separate inner and outer tube structure and distal tip of the pending independent claims and because Lee also fails to teach or suggest these elements, no combination of Lee and Mertens teaches or suggests every element of the pending independent claims and therefore the obviousness rejection of claims 22 and 32 is improper and should be withdrawn.

An early action indicating the allowability of this application is respectfully requested. The examiner is invited to telephone the undersigned at the number listed below if she has any questions regarding this amendment.

The Patent Office is hereby authorized credit any overpayment or charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 50-3629.

Dated: August 2, 2006

Respectfully submitted,

By

Michael R. Hull

Registration No.: 35,902

MILLER, MATTHIAS & HULL

One North Franklin Street

Suite 2350

Chicago, Illinois 60606

(312) 977-9902

Attorney for Applicant